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10/672,692	09/26/2003	Satoshi Hiratsuka	YAMA-0059	9284
37013 7590 06/17/2010 ROSSI, KIMMS & McDOWELL LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147				
EXAMINER WILLIAMS, JEFFERY L.				
ART UNIT		PAPER NUMBER		
2437				
NOTIFICATION DATE		DELIVERY MODE		
06/17/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail@rkmlegalgroup.com

### Office Action Summary

**Application No.**

10/672,692

**Applicant(s)**

HIRATSUKA, SATOSHI

**Examiner**

JEFFERY WILLIAMS

**Art Unit**

2437

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4 - 6, 8, 9, and 11 - 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4 - 6, 8, 9, and 11 - 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1, 4 – 6, 8, 9, and 11 – 15 are pending.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/5/10 has been entered.

***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to provide proper antecedent basis for the recitations of *and a server controlling section that ...copies the downloaded contents from one of the information processing terminals to the external apparatus or recording medium as* found recited within claim 1 (and essentially similar within claim 9).

***Claim Rejections - 35 USC § 112***

**The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1, 4, 5, 9, 11 - 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the new (or amended) claim is supported, nor does there appear to be a written description of the claim limitations in the application as filed (see above objection to the specification).

**The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** Specifically, the recitation, "the non-transitory contents supplying system" lacks antecedent basis within the claims. For the purpose of examination, the examiner presumes the applicant to recite "the contents supplying system".

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 4 – 6, 8, 9, and 11 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki et al., (Nozaki), US Patent Publication 2002/0036800 A1.**

Regarding claim 1, Nozaki discloses:

*A contents supplying server apparatus that supplies contents for downloading via a communication network (fig. 2:1; see also figs. 12 -14, par. 220-221);*

*and a plurality of information processing terminals for at least one user, contents from the server apparatus being downloadable to each information processing terminal via a communication network (fig. 2:2a, 2b, 3, 5, 6)*

*wherein the server apparatus comprises: a server storing device for storing, together with numerous contents, user information for each user, including user ID information representing a plurality of information processing terminals belonging to one user from among the at least one user and contents purchase information comprising contents ID information and copy control data, wherein the copy control data includes a total number of times the downloaded contents are allowed to be copied to an external apparatus or recording medium (fig. 3:8, see also fig. 13,14, par. 220,221 - herein*

1 Nozaki discloses a server storing device; par. 113, 190, 212-215, see also, par.  
2 63,73,80 – herein Nozaki discloses that the server apparatus is provided with copy  
3 control data indicating the maximum allowed copies as dictated by a copyright holder);  
4 *and a server controlling section that, in response to a copy permission request*  
5 *from a user: copies the downloaded contents from one of the information processing*  
6 *terminals to the external apparatus or recording medium (par. 14, 21, 103), reads out*  
7 *the copy control data of the requested downloaded contents to be copied to the external*  
8 *apparatus or recording medium from the server storing device, supplies the copy control*  
9 *data of the user to the one information processing terminal (par. 62, 63, 105-107, 113,*  
10 *146, 147 – it is herein noted that Nozaki discloses that one of the information*  
11 *processing terminals receives the copy control data), and amends the copy control data*  
12 *of the user corresponding to a request stored in the server storing device, decrements*  
13 *the total number of times the downloaded contents are copied from any of the*  
14 *information processing terminals belonging to the one user (par. 62, 63, 105-107, 113,*  
15 *207, 212 – 213 – herein Nozaki discloses that the server's copy control data is amended*  
16 *until it reaches zero, at which point the server must re-order),*  
17 *and supplies the downloaded contents, which have been previously downloaded*  
18 *by the one user, without executing a fee-charging process, to any one of the information*  
19 *processing terminals belonging to the one user, if the number of times the previously*  
20 *downloaded contents have been copied does not exceed the total number of times*  
21 *allowed to be copied (par. 12-17 – Nozaki does not disclose executing a fee charging*  
22 *process for an owner's previously owned contents),*

1            *wherein each of the information processing terminals comprises: a terminal*  
2   *storing device for storing the downloaded contents from the server apparatus (fig. 4:21);*  
3            *a sending section for sending to the server apparatus a copy permission request*  
4   *(par. 77; fig. 4:36, 28) for copying the downloaded contents to the external apparatus or*  
5   *recording medium each time before the downloaded contents are to be copied to the*  
6   *external apparatus or recording medium (par. 100, 113, 141; fig. 1). Herein, the*  
7   examiner notes that the prior art anticipates the recited structure of a "sending section"  
8   of the claimed apparatus. However, for the applicant's benefit, the examiner notes that  
9   Nozaki anticipates such intended use recitation. Regarding the applicant's description  
10   of an intended use for the "sending section", the examiner notes that Nozaki discloses a  
11   "sending section" that can be used to make a "copy permission" request each time a  
12   copy is to be made. Note, that Nozaki allows copyright holders or distribution servers to  
13   limit the copy count at their discretion, such that a user would be required to request a  
14   reuse information key before making a copy (par. 100, 113, 141; fig. 1; see also par.  
15   146).

16  
17            Regarding claim 4, Nozaki discloses:

18            *wherein said server storing device stores an initial value of the copy control data,*  
19   *contents by contents (par. 63).*

20  
21            Regarding claim 5, Nozaki discloses:

22            *wherein said contents are music data (par. 28).*

Regarding claims 6, 8, 9, 13, and 15 they are program and apparatus claims corresponding to claims 1, 4, and 5, and they are rejected, at least, for the same reasons. Furthermore regarding claims 6 and 15, Nozaki discloses:

*a receiving section for receiving the copy control data of the downloaded contents to be copied to the external apparatus or recording medium from the server apparatus (par. 78; fig. 4:30, 28);*

*and a terminal controlling section for determining whether or not to copy the downloaded contents to the external apparatus or recording medium based on the received copy control data (fig. 4:35; par. 76).*

Regarding claims 12 and 13, they recite wherein the external apparatus is an electronic musical instrument, however, the examiner notes that "the external apparatus" is not a required limitation of the claims. Therefore, though Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44), it is not necessary to address this recitation.

The examiner respectfully suggests that the applicant explicitly limit the apparatus of claim 1 and the system of claim 6 as comprising the recited electronic musical instrument.

Regarding claim 14, the examiner notes that Nozaki discloses an apparatus capable of reproducing musical notes or sounds (par. 44).



***Response to Arguments***

Applicant's arguments filed 4/2/10 have been fully considered but they are not persuasive.

*Applicant argues essentially that:*

...Applicant disagrees with the examiner's characterization of applicant's arguments.

First, the burden lies initially with the examiner to point out how Nozaki anticipates the claims. The burden shifts to applicant only if the examiner has clearly explained how the applied reference discloses each and every claim limitation, or the reference itself is sufficiently clear as to each and every claim limitation. (Remarks, pg. 7)

*The examiner respectfully responds:*

The examiner respectfully notes that nothing of record gives evidence or suggests that the prior art was unclear or that the examiner's rejection was not clearly understandable by the applicant. Thus, the examiner notes that the applicant's contention is unfounded.

*Applicant argues essentially that:*

1           Second, in contrast to the examiner's assertion, applicant respectfully submits  
2   that the examiner is the one who has failed to counter how Nozaki's passage relied  
3   upon by the examiner discloses the claimed limitation. Applicant has specifically pointed  
4   out why Nozaki fails to disclose the permission-request sending feature. Specifically, ...  
5       ...

6           More specifically, while Nozaki discloses the problem associated with paying  
7   multiple fees for the same downloaded contents ...

8       ...  
9       ... Nozaki does not disclose anywhere that the server changes the count  
10   information or keeps track of copy count information or that the PC sends the count  
11   information to the server each time it copies the already downloaded music contents. ...  
12   That is, the server does not decrement each time a copy is made by the PC.  
13       ...

14       ... The examiner has yet to address the difference or point out how Nozaki's  
15   server keeps track of the copy count.

16       (Remarks, pg. 7 – 9)

17  
18   *The examiner respectfully responds:*

19       The examiner respectfully notes that the applicant is mistaken. The applicant  
20   appears to confuse the issue of the "permission-request sending feature" with the issue  
21   of how the "server keeps track of the copy count" wherein "the server changes the count  
22   information". These are two distinct issues, and the issue of a "permission-request

sending feature" does not require or imply that a "server keeps track of the copy count" or that "the server changes the count information".

It is noted that the first issue of the "permission request sending feature" was clearly addressed by the examiner, and the applicant is respectfully encouraged to consult the official record.

Furthermore, regarding the latter issue of how the "server keeps track of the copy count" and "the server changes the count information", the examiner notes that this feature was never previously argued or recited by the applicant and is clearly seen to be have been introduced for the first time by applicant's present amendment and arguments. Thus, the applicant's contention that such a feature was properly addressed in any prior rejection or argument by the examiner is clearly illogical and is found to be unpersuasive.

Finally, regarding the applicant's present amendment and corresponding argument, the examiner points out that Nozaki does in fact disclose that the server keeps track of copy count and does change the stored value representing the copy count until the count reaches zero (par. 62, 63, 105-107, 113, 207, 212 – 213 – herein Nozaki discloses that the server's copy control data is amended until it reaches zero, at which point the server must re-order).

*Applicant argues essentially that:*

Moreover, in the interest of expediting prosecution, independent claims 1 and 9 include the features of claims 2 and 3. Specifically, these claims now define the user ID information as representing a plurality of information processing terminals belonging to one user from among the at least one user and defines the copy control data as including a total number of times the downloaded contents are allowed to be copied to an external apparatus or recording medium. These claims further define decrementing the total number of times the downloaded contents are copied from any of the information processing terminals belong to the one user, and supplying the downloaded contents, which have been previously downloaded by the one user, without executing a fee-charging process, to any of the information processing terminals belonging to the one user, if the number of times the previously downloaded contents have been copied does not exceed the total number of times allowed to be copied. (Remarks, pg. 9)

*The examiner respectfully responds:*

Examiner respectfully notes that applicant's remarks comprise only an allegation that the prior art is deficient, wherein such allegation lacks any supporting evidence or rationale. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Furthermore, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without

specifically pointing out how the language of the claims patentably distinguishes them from the references.

*Applicant argues essentially that:*

Applicant submits that Nozaki also does not disclose or teach the features of claim 3 now set forth in the independent claims. In maintaining the rejection, the examiner asserts that Nozaki's paragraphs 12-17, 89, 101, and Fig. 2: 2a, 2b, 3, 5, and 6 disclose claim 3. But these passages at best merely disclose the distribution server 1 including in the download contents, a header containing a copy count or reproducible environment information that the PC relies upon to change the count information locally. As previously mentioned, the copy count supplied in the header does not change. Rather, the PC locally changes the copy count that it manages. (Remarks, pg. 9, 10)

*The examiner respectfully responds:*

The examiner respectfully points out that applicant's argument, that the prior art fails to teach the features of previously recited claim 3, inexplicably references as support the issue of where the changing of the copy count is managed. The examiner notes that this issue is irrelevant to the features of the previously recited claim 3. Thus, applicant's arguments are found unpersuasive, at least, for this reason. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of

the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

***Conclusion***

A shortened statutory period for reply is set to expire 3 months (not less than 90 days) from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery Williams whose telephone number is (571) 272-7965. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2437

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffery Williams/  
Examiner, Art Unit 2437

/Emmanuel L. Moise/  
Supervisory Patent Examiner, Art Unit 2437